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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/578,512

04/05/2007

Christian Funke

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4985

26111

7590

02/15/2011

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
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EXAMINER

PAK, JOHN D

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

02/15/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/578,512	Applicant(s) FUNKE ET AL.	
	Examiner John Pak	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 15-72 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/7/11</u> . | 6) <input type="checkbox"/> Other: _____ |

This Office action is in reply to applicant's response of 12/2/2010.

All previously pending claims have been canceled. New claims 15-72 are now pending in this application.

It is apparent that the Examiner previously misunderstood the inventive claim structure in the restriction requirement of 12/30/2009. For example, Group II is characterized as formula I + abamectin, but that was a mistake. Such mistakes were made throughout the lack of unity requirement of 12/30/2009 because the Examiner misread most of the first component list as a list for the second component. Thus, using said Group II for illustration purpose, there was no claim that actually recited formula I + abamectin. Further, it is clear from other invention groups such as V, XVII, XIX that abamectin was determined to be distinct over other actives such as diafenthuron, spinosad, and endosulfan.

The subject matter contained in the instant claims cannot be searched together. Each active ingredient of the first component requires separate searching in the patent and non-patent literature databases. The undue search and examination burden posed by the claims necessitates the corrective action herein.

It is noted that a restriction requirement "may be made at any time before final action," as soon as the need for a proper requirement develops. MPEP 811. Here, the application is not under final rejection, and the explanation given above shows the need for a proper requirement since the previous requirement was in error. A second restriction requirement may be made when it becomes proper, even though there was a

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prior requirement. MPEP 811.02. See also MPEP 811.03 and 811.04. Therefore, the timing of the corrective restriction requirement set forth below is deemed proper.

The lack of unity requirement (restriction) of 12/30/2009 is hereby withdrawn.

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 18-19, 26-54 and 66-69, drawn to combination of I-1 or I-2 and a formula II-1 compound.

Group II, claims 20, 61-63 and 70, drawn to combination of abamectin and a formula II-1 compound.

Group III, claims 21 and 55-57, drawn to combination of diafenthiuron and a formula II-1 compound.

Group IV, claims 22 and 58-60, drawn to a combination of spinosad and a formula II-1 compound.

Group V, claims 23 and 64-65, drawn to a combination of endosulfan and a formula II-1 compound.

Claims 15-17, 24-25, 71, and 72 are readable on any of the invention groups I, II, III, IV or V, and these claims will be examined insofar as they read on the elected invention group.

Applicant is further required to elect a single disclosed species of formula II-1 compound, such as for example compound II-1-4.

Under lack of unity rules, unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or

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corresponding special technical features. The expression “special technical features” is defined as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The “contribution over the prior art” is considered with respect to novelty and inventive step. Further, under Markush practice, all alternatives must have a common property AND (i) common structure must be present in all alternatives or (ii) all alternatives must belong to a recognized class of chemical compounds. See PCT Rule 13.1 and 13.2; see also MPEP 1850.

Here, the technical relationship among the claimed inventions is the common use of the compound of formula II-1. However, compounds of formula II-1 are known in the prior art for their pesticidal properties, as acknowledged by Applicant in the instant specification page 12, line 25 to page 13, line 1. Consequently, the same or corresponding feature in all of the inventions does not define a contribution which each of the inventions makes over the prior art.

Regarding the various first active ingredients, it must be noted that there is no common structure and all alternatives do not belong to a recognized class of chemical compounds.

Therefore, the inventions are not so linked as to form a single general inventive concept; and the inventions lack unity of invention.

Moreover, to search and examine more than one invention group would place an undue burden on the Examiner. Each of the invention groups are separately classified and thus must be separately searched. Group I is classified in, inter alia, class 514,

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subclass 462; Group II is classified in, inter alia, class 514, subclasses 30; Group III is classified in, inter alia, class 514, subclass 587; Group IV is classified in, inter alia, class 514, subclass 28; Group V is classified in, inter alia, class 514, subclass 431. Not only is there a separate search in the patents database for each of the inventions, there is also a divergent non-patent literature search necessary for each of the invention groups due to the distinct chemical structures of the components. In the absence of a nexus type teaching, a prior art reference for one invention may not be applicable to the other inventions. In sum, under the facts of this application, the additional search and examination necessary for additional invention(s), which lack unity of invention, would rise to the level of undue burden.

For these reasons, the claims lack unity of invention.

Applicant is advised of US 2008/0027046, which claims domestic priority to 60/584,601, filed on July 1, 2004. It is noted that this date is earlier than Applicant's International filing date but not earlier than Applicant's German priority date. The provisional application discloses the mixture of Applicant's compound II-1-4 + various compounds such as spiromesifen. US 2008/0027046 may be applied as prior art in the next Office action in the absence of a certified translation perfecting Applicant's foreign priority. This information is being provided to Applicant in order to expedite the further prosecution of this application.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Johann Richter, can be reached on **(571)272-0646**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John Pak/
Primary Examiner, Art Unit 1616